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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

LASHLEY, LAUREL L

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 08/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/075,445	MONT ET AL.	
	Examiner	Art Unit	
	Laurel Lashley	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 2/15/2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-38 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-38 is/are rejected.
- 7) Claim(s) 9,22 and 36 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 0103970.0.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 2/15/2002
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. Claims 1 – 38 have been examined.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 0103970, filed on 02/17/2001.

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawings are objected to because the unlabeled figures shown in the drawings should be provided with descriptive labels. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

Art Unit: 2132

the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The specification is objected to because of the following informalities:

- Referencing a drawing that does not exist (see page 11, lines 5 and 19; reference made to 36RM). Appropriate correction is required.
- Improper use of a punctuation (see page 3, line 29; duplicate period at the end of the sentence). Appropriate correction is required.
- Labeling omitted for contents of the specification:

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).
- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer

Art Unit: 2132

program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where

Art Unit: 2132

elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing: See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

6. The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing

Art Unit: 2132

the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f). (See page 3, line 14; reference made to US Patent 4,868,877). Appropriate correction is required.

7. The disclosure is objected to because of the following informality: fails to list a US Patent mentioned in the specification (see page 3, line 14; reference made to US Patent 4,868,877). Appropriate correction is required.

Claim Objections

8. Claim 36 is objected to because of the following informality: incorrect claim format (see page 20, line 33; missing period at end of sentence). Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A digital certificate, as it is presented, is not able to realize its functionality absent being embedded on a medium which enables a computer to read and execute the certificate to produce a useful, concrete and tangible result. Note that amending claims 1 - 34 to recite "A digital certificate" -- embodied on a computer readable medium-- would overcome this rejection.

Additionally, claims 1 and 33 are further rejected under 35 U.S.C 101 as being non-statutory subject matter for the use of "executable file". The specification does not

Art Unit: 2132

clarify this usage, which can also be interpreted as data thus rendering claims 1 and 33 directed to non-functional descriptive material.

10. To expedite a complete examination of the application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1 – 8, 10 –15, 23 - 30 and 33 – 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Tyckensen et al in US 6,189,097 (hereinafter US '097).

For claim 1, US '097 teaches:

A digital certificate comprising a plurality of credential attribute properties (see column 6, lines 16 and 41-56), and a trust function embedded within the certificate as an executable file, which trust function has data can determine as a function of data available to it a trust value attributable to at least a part of the digital certificate at least partly by execution of the executable file (see column 3, lines 28 - 31).

For claim 2, US '097 teaches:

Art Unit: 2132

A digital certificate according to claim 1, in which the trust value is of a credential attribute in the certificate (see column 3, line 40).

For claim 3, US '097 teaches:

A digital certificate according to claim 1, in which the trust value is of the certificate (see column 3, line 39).

For claim 4, US '097 teaches:

A digital certificate according to claim 1, in which the data is trust value data (see column 6, lines 27 - 28).

For claim 5, US '097 teaches:

A digital certificate according to claim 1, in which the data includes data obtained externally of the certificate (see column 10, lines 2 – 3).

For claim 6, US '097 teaches:

A digital certificate according to claim 5, in which the obtained data is obtained from a user by the input of data in response to a query generated by the trust function (see column 12, lines 17 – 20).

For claim 7, US '097 teaches:

A digital certificate according to claim 5, in which the obtained data is obtained from a digital data store (see column 4, lines 46 - 47).

For claim 8, US '097 teaches:

A digital certificate according to claim 7, in which the digital data store is a website (see column 6, lines 59 - 60).

For claim 10, US '097 teaches:

A digital certificate according to claim 1, in which the trust function is configured to determine the trust value automatically (see column 12, lines 10 - 12 where it is inherent that the "try before you buy" feature is automatically enabled upon execution).

For claim 11, US '097 teaches:

A digital certificate according to claim 1, in which execution of the executable file fully can determine the trust value (see column 4, lines 27 – 28 and Figure 14).

For claim 12, US '097 teaches:

A digital certificate according to claim 1, in which the executable file is a platform portable code (see column 7, lines 55 - 58).

For claim 13, US '097 teaches:

A digital certificate according to claim 1, in which the certificate had a valid period and the credential function determines the credential attribute property value during the valid period (see column 6, line 49).

For claim 14, US '097 teaches:

A digital certificate according to claim 1, in which the plurality of credential attribute properties are from a single credential attribute (see column 6, lines 28 - 29).

For claim 15, US '097 teaches:

A digital certificate according to claim 1, in which 30 the plurality of credential attribute properties are from a plurality of credential attributes.

As it pertains to claim 23, US '097 teaches:

Art Unit: 2132

A digital certificate according to claim 18, in which the credential function is configured to determine the credential attribute property value automatically (see column 12, lines 12 – 13 where there is a copy of the initial “try before you buy” function).

For claim 24, US '097 teaches:

A digital certificate according to claim 18, in which execution of the executable file fully can determine the credential attribute property value (see column 4, lines 27 - 28 and Figure 14).

For claim 25, US '097 teaches:

A digital certificate according to claim 18, in which the executable file is a platform portable code (see column 7, lines 55 - 58).

For claim 26, US '097 teaches:

A digital certificate according to claim 18, in which the credential attribute property comprises a value operated on by the credential function to determine a credential attribute property value (see column 10, lines 27 - 33).

For claim 27, US '097 teaches:

A digital certificate according to claim 18, in which the credential function uses data obtained from outside the certificate to determine the credential attribute property value (see column 10, lines 2 - 3 where importing indicates that data is obtained from an external source).

For claim 28, US '097 teaches:

Art Unit: 2132

A digital certificate according to claim in which the obtained data is obtained from a user by the input of data in response a query generated by the credential function (see column 12, lines 17 - 20).

For claim 29, US '097 teaches:

A digital certificate according to claim 27, in which the obtained data is obtained from a digital data store (see column 4, lines 46 - 47).

For claim 30, US '097 teaches:

A digital certificate according to claim 29, in which the data store is a web site (see column 6, lines 59 - 60).

For claim 33, US '097 teaches:

A digital certificate comprising a plurality of credential attribute properties (column 6, lines 16 and 41 - 56) and a trust function within the certificate, which trust function comprises an executable file, which trust function has data available to it and can determine as a function of the data available to it a trust value attributable to at least a part of the digital certificate at least partly by execution of the executable file (column 3, lines 28 - 31).

For claim 34, US '097 teaches:

A digital certificate comprising a plurality of credential attribute properties (column 6, lines 16 and 41 - 56), and a trust function embedded within the certificate as an executable program, which trust function has data available to it and can determine as a function of the data available to it a trust value attributable to at least a part of digital

Art Unit: 2132

certificate at least partly by execution of the executable program (column 3, lines 28 - 31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 16 - 21 and 31 - 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over US '097 as applied to claim 1, above, further in view of Sudia in US 5,659,616 (hereinafter US '616).

As it relates to claims 16 - 21 and 31 – 38, Tyckensen et al teaches a digital certificate by does not explicitly teach the latter characteristics of the certificate as taught by Sudia.

For claim 16, US '097 teaches a digital certificate but it does not teach that there is at least one attribute trust value, in which the trust function uses an attribute trust value to determine the trust value as taught by Sudia in US '616 (see column 6, lines 63 - 64).

For claim 17, while US '097 teaches a digital certificate, it does not teach that there is a plurality of credential attributes and a plurality of attribute trust values, in which the trust function uses a plurality of attribute trust values to determine the trust value as taught by US '616 (see column 7, lines 1 - 7).

Art Unit: 2132

For claim 18, while US '097 teaches a digital certificate, it does not teach that a credential function is provided in the certificate, which credential function is associated with at least one credential attribute property and which determines the value of the credential attribute property as taught by US '616 (see column 7, lines 26 - 28).

For claim 19, while US '097 discloses a digital certificate, it does not teach that the trust function uses the credential attribute property value determined by the credential function as taught by US '616 (see column 9, lines 13 - 15).

Claim 20 is disclosed in US '097 as a digital certificate but does not explicitly teach that the credential attribute property value determined by the credential function is a trust value as taught by US '616 (see column 9, lines 65 - 67).

Claim 21, teaches a digital certificate as in US '097 but does not teach that the certificate has a valid period and the trust function determines the trust value during the valid period of the certificate as taught by US '616 (see column 6, line 49).

For claim 31, while US '097 teaches a digital certificate, it does not teach a plurality of the credential attribute properties have respective credential functions as in US '616 (see column 6, lines 64 – 67; as taught by example).

For claim 32, while US '097 teaches a digital certificate, it does not teach that each credential attribute property has a respective credential function as in US '616 (see column 7, lines 17 - 24; as taught by example).

For claims 16 - 21 and 31 - 32, it would be obvious to modify Tyckensen's (US '097) method to Sudia's (US '616) for the purpose of verification (i.e. credential attribute,

Art Unit: 2132

function or property) and indicating a level of confidence for the certificate (i.e. trust value or function).

As it relates to claims 35 – 38, Tyckensen et al teaches a digital certificate but does not explicitly teach the communication of the certificate from source to sender as taught by Sudia in US '616.

For claim 35, US '097 teaches a digital certificate but does not teach a method of communication, which method comprises the steps of communicating from a sender to a recipient as taught by Sudia in US '616 (see column 18, line 31; where it is inherent that a communication system incorporates sending and receiving of a message i.e. a certificate).

For claim 36, US '097 incorporates the communication of claim 35 but does not teach that the recipient inspects the certificate and the trust value is determined by the trust function as taught by US '616 (see column 9, lines 37 - 46).

For claim 37, US '097 incorporates the communication of claim 35 but does not teach that the recipient inspects the certificate and the credential attribute property value is determined according to the credential function as taught by US '616 (see column 9, lines 47 - 64).

Claim 38 incorporates the communication of claim 35, but does not explicitly teach that the communication is via a distributed electronic network as in US '616 (see column 1, line 19; where it is inherent that a digital certificate is an electronic document and thus it must be communicated on an electronic network).

Art Unit: 2132

For claims 35 - 38, it would be obvious to modify Tyckensen's (US '097) method to Sudia's (US '616) for the purpose of utilizing its functionality of communicating the digital certificate from a source to a recipient.

Allowable Subject Matter

13. Claim 9: "A digital certificate according to claim 1, in which the trust function varies the trust value as a function of time" is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 22: "A digital certificate according to claim 18, in which the credential function varies the credential attribute property value as a function of time" is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2132

14. Claims 1 - 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/075380. Although the conflicting claims are not identical, they are not patentably distinct from each other because Applicant's trust function operates in the same manner as the credential attribute function in the copending Application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurel Lashley whose telephone number is 571-272-0693. The examiner can normally be reached on 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, Jr. can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Laurel Lashley
Patent Examiner
Art Unit 2132

lll August 15, 2005

Gilberto Barron Jr.
GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100